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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,855	06/14/2006	Daisuke Kawasaki	8017-1193	6622
466 7590 04/15/2010 YOUNG & THOMPSON 209 Madison Street Suite 500 Alexandria, VA 22314			EXAMINER MERCADO, JULIAN A	
			ART UNIT	PAPER NUMBER
			1795	
			NOTIFICATION DATE	DELIVERY MODE
			04/15/2010 ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketingDept@young-thompson.com

Office Action Summary

Application No.

10/582,855

Applicant(s)

KAWASAKI ET AL.

Examiner

JULIAN MERCADO

Art Unit

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Remarks

This Office action is responsive to applicant's amendment filed on January 19, 2010.

Claims 1-20 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

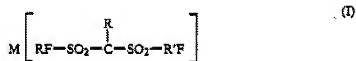
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 12, 15-18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al. (2002/0037458) in view of Armand (U.S. Pat. 4,818,644).

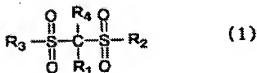
This rejection is maintained for the reasons of record. Applicant's arguments filed with the present amendment have been fully considered, however they are not found persuasive for the following reasons. Applicant submits that R₁ and R₄ now recites a *substituted* alkyl group having 1 to 5 carbon atoms. (emphasis in remarks on page 10) To this end, applicant submits that formula (I) of Armand must have at least one hydrogen substituted to its central carbon. This argument is not persuasive. Note that Armand's formula (I) is ionized, which means that the counterion is provided for by element "M" and not another hydrogen substituent. Assuming *arguendo* that applicant's argument has merit, it is further noted that the claimed formula (I) also recites that "R₁ and R₄ independently represent an atom or a group selected from a *hydrogen*

atom...." (emphasis added) As to the argument that R₂ and R₄ now recite an *unsubstituted* alkyl group having 1 to 5 carbon atoms (emphasis in remarks on page 10), this alleged distinction is not persuasive as the claimed formula (I) also recites that R₂ and R₄ may be a "substituted or unsubstituted fluoroalkyl group having 1 to 5 carbon atoms...", which Armand clearly teaches by way of its perhalogenated end groups RF and R'F.

For reference, the electrolyte solution disclosed by Armand is reproduced herein, and is a compound represented by the following structure:



which, as set forth in the prior Office action, is notably *the same chain disulfonate* as recited in the claimed general formula (1):



Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al. (2002/0037458) in view of Armand (U.S. Pat. 4,818,644) and further in view of Fleischer et al. (U.S. Pat. 6,225,009).

This rejection is maintained for the reasons of record. The examiner notes that no salient arguments are presented therefor.

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al. (2002/0037458) in view of Armand (U.S. Pat. 4,818,644) and further in view of Utsugi et al. (2004/0043300).

This rejection is maintained for the reasons of record. The examiner notes that no salient arguments are presented therefor.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al. (2002/0037458) in view of Armand (U.S. Pat. 4,818,644) and further in view of Shiota (U.S. Pat. 5,795,674).

This rejection is maintained for the reasons of record. The examiner notes that no salient arguments are presented therefor.

Double Patenting

Claims 1-9, 12, 15-18 and 20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 13 of copending Application No. 10/541,063 (the '063 application) in view of Yamaguchi et al.

Claims 10 and 11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 13 of the '063 application in view of Yamaguchi et al. and Fleischer et al.

Claims 13 and 14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 13 of the '063 application in view of Yamaguchi et al. and Utsugi et al.

Claim 19 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 13 of the '063 application in view of Yamaguchi et al. and Shiota.

This is a provisional obviousness-type double patenting rejection. Any differences between the '063 application and the instant application is deemed non-obvious in view of the teachings of Yamaguchi et al., Fleischer et al., Utsugui et al. and Shiota et al. as applied in this Office action. It is noted that both the '063 application and the instant application both recite the same chain disulfonate as recited in the claimed general formula (1).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

In maintaining this ground of rejection, the examiner notes that applicant has requested the double patenting rejection be forestalled until the copending application issues as a patent. In reply, the examiner notes that the present rejection is a provisional obviousness-type double patenting rejection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian Mercado whose telephone number is (571) 272-1289. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan, can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

/Julian Mercado/
Examiner, Art Unit 1795

/PATRICK RYAN/
Supervisory Patent Examiner, Art Unit 1795